

REMARKS

In the Office Action dated October 14, 2008, claims 1-22 were presented for examination. Claims 1-5, 8-12, and 12-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Second Copy* in view of *Knight*, U.S. Patent No. 7,043,619. Claims 6, 7, 13, 14, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Second Copy* in view of *Knight*, U.S. Patent No. 7,043,619, and further in view of *Whiting et al.*, U.S. Patent No. 5,778,395.

The following remarks are provided in support of the pending claims and responsive to the Office Action of October 14, 2008 for the pending application.

I. Rejections To Claims 1-5, 8-12, and 12-20 Under 35 U.S.C. §103(a)

In the Office Action dated October 14, 2008, the Examiner rejected claims 1-5, 8-12, and 12-20 under 35 U.S.C. §103(a) as being unpatentable over *Knight* in view of *Second Copy*.

Applicants' remarks in relation to *Second Copy* and *Knight* made in previous communication are hereby incorporated by reference.

Pursuant to an Examiner Interview of January 12, 2009, Applicants have amended the claims to distinguish their invention over the prior art and overcome the rejection of record. The following remarks clarify the differences between the prior art and the claimed invention of Applicants as amended.

The invention of *Knight* discloses network configuration software executing on a client computer system that provides a management console to the network administrator for performing various network configuration and/or management functions. The network configuration software includes a Discoverer operating to automatically detect existing storage in the network system and creating a FreeSpace.xml file. The Discoverer queries disk (or LUN) objects registered by a volume manager. See col. 5, lines 10-22, col. 7, lines 63-67 and Fig. 6. Accordingly, the Discoverer detects available free space in storage devices to which it has **direct**

access.

In contrast, since the Central System Server of Applicants can not directly access all servers and clients, it receives all information regarding available disk space from daemon applications installed on multiple systems (servers and clients). By creating a central file, the Central System Server dynamically coordinates backup and restoration of files for which direct access is not available. See [0020], [0021], and [0029] of Applicants' published application. One of the primary differences between the invention of Applicants and the teaching of *Knight* is that *Knight* embodies an environment where only direct access is supported, while Applicants' invention provides for an environment where direct access is not available. In other words, the teaching of *Knight* is limited to a direct access environment. In contrast, Applicant' invention supports an indirect access environment, an environment not supported by *Knight*.

Furthermore, the Examiner argues that the Storage Configurator Program of *Knight* is equivalent to a daemon application. Applicants respectfully disagree. More specifically, the Storage Configurator Program of *Knight* runs on one of the client machines accessing system storage devices to collect information about available storage space. In contrast, the daemon applications of Applicants run on multiple client and server machines sending free space information to the Central System Server. Accordingly, the Central System Server of Applicants possesses information on **all storage devices on a network, not only on storage devices to which it has direct access.**

With respect to *Second Copy*, information about "what to copy", "where to copy," and "when to copy" is maintained in the Profile. In *Second Copy* a user can decide where to store backup files.¹ The aspect of selecting a location for storage of a backup file is manual. In contrast, in Applicants' invention, **the backup application** decides where to store backup files without the need for user intervention. More specifically, the backup application of Applicants selects at least one system available from the master file, and the user selection process is eliminated. Claims 1, 8, and 15, as amended, emphasize the above aspect of the invention.

¹See screenshot of *Second Copy* attached as Exhibit A.

More specifically, the amendments address the backup file selection process to further distinguish the invention over the prior art of record. Support for the amendments can be found in paragraphs [0044] and [0045] of Applicants' published patent application. No new matter has been added to the pending application with the amendments submitted herewith.

In order for the claimed invention to be unpatentable under 35 U.S.C. §103(a), the prior art must teach all claimed limitations presented by the claimed invention. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."² As clearly identified herein, it is Applicants' position that *Knight* and *Second Copy*, either read in combination or individually, do not teach all of the claim limitations in view of the amendments submitted herewith. Accordingly, Applicants respectfully request that the Examiner remove the rejections under 35 U.S.C. §103(a) and grant an allowance of claims 1-5, 8-12, and 12-20.

II. Rejections To Claims 6, 7, 13, 14, 21, and 22 Under 35 U.S.C. §103(a)

In the Office Action dated October 14, 2008, the Examiner rejected claims 6, 7, 13, 14, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over *Knight* in view of *Second Copy*, and in further view of *Whiting*.

Applicants' remarks in relation to *Second Copy* and *Knight* made above and in previous communication are hereby incorporated by reference.

The Examiner employs *Whiting* in relation to receiving a list of files to be restored and determining which system stores the files. *Whiting* discloses a system for backing up files from disk volumes on multiple nodes of a computer network to a **common random-access backup storage means**. In contrast, Applicants' invention is directed to storing backup files on one or more client and/or server machines on a network with available disk space. The disclosure of *Whiting* pertains to employing additional hardware such as the **common random-access backup storage means** for backing up files. As is clearly defined in the claims, as amended, the

²*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

central system of Applicants transmits a list of files to be restored to a backup application. Subsequently, the backup application connects to the one or more daemon applications on the one or more systems storing the files to be restored. Accordingly, the backup process of *Whiting* does not teach or suggest the structure and hardware employed by Applicants.

Furthermore, to uphold a rejection under 35 U.S.C. § 103(a) for a dependent claim, all the claim limitations must be taught or suggested by the prior art.³ In other words, the prior art reference(s) must teach or suggest all limitations of the dependent claims and the independent claim from which it depends. It is Applicants' position that the combination of *Knight* and *Second Copy* in view of *Whiting*, applied separately or in combination, do not teach all of the Applicants' claimed limitations. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 6, 7, 13, 14, 21, and 22 and grant an allowance thereof.

III. Conclusion

In view of the forgoing remarks to the claims, it is submitted that all of the claims remaining in the application are now in condition for allowance and such action is respectfully requested. Applicants are not conceding in this application that those claims in their prior forms are not patentable over the art cited by the Examiner, as the present claims are only for facilitating expeditious prosecution of the application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

³ MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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EXHIBIT A

